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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 01/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/001,475

Applicant(s)

GROZ, MARK MICHAEL

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101 and 35 USC § 112

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts”

when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

- (a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.

- ii. If the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdan*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed.

Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it.

If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a

“concrete” result. Usually, this question arises when a result cannot be assured.

An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

4. Claims 13 and 17 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically:
5. In Claims 13 and 17, the ambiguities cited would make it impossible for the process to be repeatable or “concrete.” In other words, different users would come up with different responses.
6. As per Claims 13 and 17, it appears that the method is attempting to sell a valuation estimation system - which can be integrated with a negotiation service, whereas the valuation estimate is dependent on independent criteria provided by the client. These

independent criteria could contain a vast amount of different setting combinations – which would include different settings for each of the following: the model selected, model weighting factors, the inputs selected, input weighting factors, the entities selected, and entity weighting factors. Thus, this method is not repeatable and would appear to be an attempt to patent an abstract idea not a “concrete” process.

7. Claims 13 and 17 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention lacks a patentable utility, for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.
8. Claim 18 is rejected, as it depends on a rejected independent claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Collins et al. (US 2002/0007362 A1).**
11. As per independent Claims 1 and 12, Collins discloses a method / system for using a computer to solve problems involving a plurality of agents comprising: receiving by said

computer a request to participate in a new or existing problem-solving group; submitting an update to a database storing information about agents, contingent commitments, and rules for processing said commitments to discover potential solutions (Para53-38); sending an update notification to agents in the problem-solving group according to agent definable criteria, said notification comprising: an indication that a new agent has joined the problem-solving group; a description of solutions, if any, discovered by processing of the contingent commitments according to the rules of the database, with an indication of solution type, for each solution; information about said agent; and information about one or more contingent commitments of said agent (Figs. 1a-3, Para 0041-0042, Para 0053-0058, Claims 1-8, Claim 16).

12. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Thiessen (US 5,495,412).

13. As per independent Claim 14, Thiessen discloses a method for using a computer to conduct a negotiation between two agents, said negotiation comprising: receiving by said computer a request from an agent to negotiate with another agent; notifying an agent by said computer of an opportunity to negotiate with another agent receiving by said computer data related to a negotiation between two agents; performing a calculation to determine whether the negotiating produces a value acceptable to said agents; notifying said agents of the outcome of a negotiation; facilitating real-time communication between agents before, during , and after the negotiation session (Abstract, Figs.1-3, C2 L33-61, C3 L11-67, C4 L1-63, Claims 1-11).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-3, 5-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Collins et al. in view of Thiessen.

16. As per Claim 2, Collins fails to disclose wherein information about said agent is

controlled by privacy filters that can be removed only by said agent.

17. Thiessen teaches wherein information about said agent is controlled by privacy filters that

can be removed only by said agent (Abstract, C4 L45-63, C5 L42-65, C6 L16-43).

18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included wherein information about said agent is controlled

by privacy filters that can be removed only by said agent, as disclosed by Thiessen in the

system disclosed by Collins, for the advantage of providing a method for using a

computer to solve problems involving a plurality of agents with the ability to maintain

user confidentiality so as to not compromise each users negotiation tactics.

19. As per Claim 3, Collins and Thiessen disclose wherein information about one or more

contingent commitments of said agent is controlled by privacy filters that can be removed

only by said agent (Thiessen: Abstract, C4 L45-63, C5 L42-65, C6 L16-43).

20. As per Claim 5, Collins and Thiessen disclose wherein said request includes at least one contingent commitment relating to the problem (Collins: Abstract, Figs. 1a-3, Para 0041-0042, Para 0053-0058, Claims 1-8, Claim 16).
21. As per Claim 6, Collins and Thiessen disclose wherein one of said solutions may be converted into a binding agreement among the agents or a subset of the agents (Collins Abstract, Para 0052).
22. As per Claim 7 and 9, Collins and Thiessen fail to disclose receiving an identifier specifying form of payment and account information to be used in providing payments related to problem solving group participation and/or transactions arising from solutions, receiving an express authorization to charge said account for said problem solving group participation.
23. However, web commerce was well established at the time the invention was made and therefore, it would have been obvious to except payment for dispute resolution services offered over the Internet by having the user identify the type of payment they wanted to use and receive express authorization to charge an account if necessary.
- 24. Claims 4, 8, 10, and 11 are rejected under 35 U.S.C. 103 as being unpatentable over Collins et al.**
25. As per Claim 4, Collins does not expressly show wherein said solutions may be of the following types: binding, nonbonding, subject to vote, subject to future contingencies.
26. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The dispute resolution method/system would be performed regardless of the type of solution reached. Thus, this descriptive

material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have offered binding, nonbonding, subject to vote, subject to future contingencies as possible solution to a dispute, because such a solution does not functionally relate to the steps in the method claimed and because the subjective interpretation of the solution does not patentably distinguish the claimed invention.
28. As per Claim 8, Collins does not expressly show wherein the form of payment includes at least one of the following: credit card, debit card, Paypal, c2it, checking account transfer, or other electronic funds transfer.
29. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The dispute resolution method/system would be performed regardless of the form of payment used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
30. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have accepted credit card, debit card, Paypal, c2it, checking account transfer, or other electronic funds transfer, as a form of payment for serves rendered, because such data does not functionally relate to the steps in the method

claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

31. As per Claim 10, Collins does not expressly show wherein said express authorization is received from one of the following: a credit card issuer, a debit card issuer, a bank, or other electronic funds transfer system sponsor.

32. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The dispute resolution method/system would be performed regardless of the where the express authorization is received. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have received express authorization from credit card, debit card, Paypal, c2it, checking account transfer, or other electronic funds transfer a credit card issuer, a debit card issuer, a bank, or other electronic funds transfer system sponsor, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

34. As per Claim 11, Collins does not expressly show wherein said problems includes at least one of: a negotiation among a plurality of parties concerning the price of a collection of goods and/or services; a negotiation among a plurality of parties concerning a scalar value, other than price, relating to a collection of goods and/or services; a negotiation

among a plurality of parties relating to venture capital investing; a negotiation among a plurality of parties relating to joint venture undertaking; a negotiation among a plurality of parties relating to the development of intellectual property; a negotiation among a plurality of parties relating to internal corporate strategic planning; a negotiation among a plurality of parties concerning the scheduling of one or more meeting, events, or processes; a negotiation among a plurality of parties concerning the early adoption of new products and/or services; a negotiation among a plurality of parties concerning terms of settlement of a legal dispute; a negotiation among a plurality of parties concerning disposition of funds for charitable purposes; a negotiation among a plurality of parties concerning conduct of central bank policy; a negotiation among a plurality of parties concerning government or inter-governmental policy-making; and a negotiation among a plurality of parties relating to group activities.

35. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The dispute resolution method/system would be performed regardless of the types of problems disputed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
36. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have resolved a multitude of problem types, because such a problem type does not functionally relate to the steps in the method claimed and because

the subjective interpretation of the problem type does not patentably distinguish the claimed invention.

37. Claims 15 and 16 are rejected under 35 U.S.C. 103 as being unpatentable over Thiessen.

38. As per Claim 15, Thiessen does not expressly show wherein the subject of said negotiation is a price or other scalar quantity associated with a collection of goods, services, or other assets and/or liabilities, whether tangible or intangible.

39. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The dispute resolution method/system would be performed regardless of the negotiation subject. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

40. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have negotiated a price or other scalar quantity associated with a collection of goods, services, or other assets and/or liabilities, whether tangible or intangible, as part of the method/system, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

41. As per Claim 16, Thiessen does not expressly show wherein one of said agents is a buyer and a second of said agents is a seller.

42. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The dispute resolution method/system would be performed regardless of who the agent is. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
43. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the system/method to solve problems between a buyer and seller, because such agents do not functionally relate to the steps in the method claimed and because the subjective interpretation of the agents do not patentably distinguish the claimed invention.

Response to Arguments

44. Applicant's arguments filed 9/25/2003 have been fully considered but they are not persuasive. The rejection will remain as final, based on the cited prior art.
45. The applicant makes the argument that Claims 13 and 17 should not be rejected under 35 U.S.C. 101 because, although the method uses different inputs and arrives at different estimates, it is not an ambiguity of the method, but rather a characteristic of estimates.
46. However as explained in the 101 rejection above, the ambiguities (or different inputs) cited would make it impossible for the process to be repeatable or "concrete" – and an invention is ineligible for patenting under 35 U.S.C. § 101, unless it is in the "useful arts"

when it is a machine, manufacture, process or composition of matter, which produces a **concrete**, tangible, and useful result.

47. Furthermore, due to the requirements for different inputs - which cause the method to arrive at different estimates - Claims 13 and 17 lack patentable utility, because the invention cannot operate as intended without undue experimentation.

48. The applicant also makes the argument that the prior art of Collins et al. (US 2002/0007362 A1) does not teach the use of contingent commitments.

49. However, Collins does teach wherein the dispute parties may propose a fair resolution (contingent commitment) for each issue - which will constitute the parties fair resolution set (Para 0055).

50. The Applicant makes the argument that the prior art of Thiessen (US 5,495,412) fails to disclose the use of real-time communications between agents to complement the automatic negotiation.

51. However, Thiessen does disclose wherein the Process Support System assists parties in **real time** toward achieving an optimal, mutually satisfactory agreement in dynamic multi-issue, multi-party negotiations (C3 L13-18).

52. Finally, the applicant makes the argument that the prior art of Thiessen fails to disclose how to negotiate the value of a scalar quantity and negotiations in which one agent is a buyer and another is a seller.

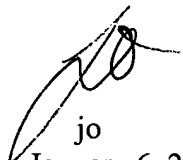
53. However, as explained in the rejections of Claims 15 (which only states: wherein the subject of said negotiation is a price or other scalar quantity) and 16 above, these

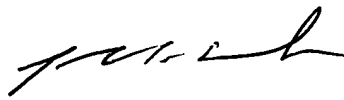
differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited.

54. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the claimed data, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Conclusion

55. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
56. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.
57. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.


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January 6, 2004


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